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Raymond E. Scott
HOWARD & HOWARD ATTORNEY, P.C.
39400 Woodward Avenue - Suite 101
Bloomfield Hills, MI 48304

In re Application of
DEWEERD, Herman *et al*
U.S. Application No.: 09/674,585
PCT No.: PCT/US99/16412
Int. Filing Date: 20 July 1999
Priority Date: 23 July 1998
Attorney Docket No.: 60132-074
For: ELECTRO-OPTICAL MECHANICAL
INSTRUMENT

DECISION ON
PETITION UNDER
37 CFR 1.47(a)

This is a decision on applicants' "Petition for Filing Application Without All Inventors Signing" filed 20 August 2001.

BACKGROUND

On 18 January 2001, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath/declaration in compliance with 37 CFR 1.497(a) and (b) and a surcharge fee pursuant to 37 CFR 1.492(e) must be provided. Applicants were given one month to respond. Extensions of time were available under 37 CFR 1.136(a).

On 03 July 2001, applicants submitted a "Response to Notification of Missing Requirements . . ." which was accompanied by, *inter alia*, a five-month extension and fee; the \$65.00 surcharge fee; and a declaration signed by two of the three co-inventors.

On 27 July 2001, the DO/EO/US mailed a Notification of Defective Response (Form PCT/DO/EO/916) and Notification of a Defective Oath or Declaration (Form PCT/DO/EO/917) indicating that the declaration submitted was not in compliance with 37 CFR 1.497 because one of the three co-inventors, Jose Hernandez did not sign the declaration. Applicants were given one month to respond with no extension of time available.

On 20 August 2001, applicants filed the instant petition which was accompanied by, *inter alia*, a declaration signed by two of the three co-inventors; a "Declaration of Cheryl Boisclair" ("Decl."); and authorization to charge any required fees to Deposit Account No. 08-2789.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the required petition fee; (2) factual proof that the missing joint inventor refuses to execute the application or cannot be found or reached after diligent effort; (3) a statement of the last known address of the missing joint inventor; (4) and an oath or declaration executed by the signing joint inventor on his behalf and on behalf of the non-signing joint inventor.

The required petition fee of \$130.00 as set forth in 37 CFR 1.17(i) has been charged to Deposit Account No. 08-2789 as authorized. Item (1) is complete.

Regarding item (3), the last known address of Mr. Hernandez is listed as:

81 Cross Street
Apt. No. 2
Somerville, MA 02145

Concerning item (2), applicants included a declaration by Ms. Boisclair who states that "[o]n February 19, 2001, a copy of the declaration and assignment associated with Patent Application No. 09/674,585 was forwarded to each of the inventors, including Jose Hernandez, at the last known address of Jose Hernandez." Decl. ¶ 4. Then, Ms. Boisclair declares that after receiving no response from Mr. Hernandez that "[o]n April 18 2001, I called Jose Hernandez at his last known telephone number . . . on which I left a message that was not returned." Id. at ¶ 6. Ms. Boisclair states she called Mr. Hernandez at least two more times without receiving a response and finally that "[o]n May 10, 2001, Gregory D. Grazia . . . forwarded a letter and additional copies of assignment and declaration papers to each of the inventors, including Jose Hernandez at his last known address. As of June 11, 2001, no response has been received from Jose Hernandez." Id. at ¶ 8. Finally, Ms. Boisclair claims that "[a]fter repeated attempts, I have not been able to ascertain the location of Jose Hernandez." Id. at ¶ 9.

Applicants' burden in proving that an inventor cannot be located pursuant to item (2) is explained in section 409.03(d) of the MPEP (8th Ed.) which states, in part:

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made . . .

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover

letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included [in the] statement of facts. It is important that the statement contain facts as opposed to conclusions.

In the instant petition, applicants have not included any documentary evidence such as copies of the letters and certified mail receipts sent to Mr. Hernandez's last known address. In addition, Ms. Boisclair did not identify any steps she took to locate the whereabouts of Mr. Hernandez such as internet searches etc. For these reasons, item (2) is not satisfied.

Concerning item (4), applicants included two different declarations signed by two of the three co-inventors. The nonsigning co-inventors' names, residences, post office addresses and citizenship are typed on the declaration signed by Michael Beach. This declaration satisfies the requirements of section 409.03(a) of the MPEP and is in compliance with 37 CFR 1.497(a) and (b). However, the declaration signed by Herman DeWeerd does not indicate the citizenship of any of the co-inventors. This declaration is not in compliance with 37 CFR 1.497(a)(3). Thus, item (4) has not been satisfied.

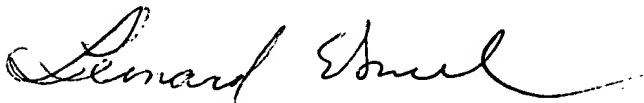
For this reason, all of the requirements of 37 CFR 1.47(a) are not yet complete.

CONCLUSION

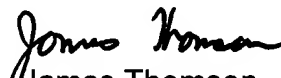
The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.



Leonard Smith
PCT Legal Examiner
PCT Legal Office



James Thomson
Attorney Advisor
PCT Legal Office

Tel.: (703) 308-6457